

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing: May 9, 2023

Mailed: July 17, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

—  
Trademark Trial and Appeal Board  
—

*In re MercadoLibre, Inc.*  
—

Serial Nos. 88950207 and 88950420<sup>1</sup>  
—

Kristina Montanaro Schrader and Maia T. Woodhouse of Adams and Reese LLP,  
for MercadoLibre, Inc.

Jason Nehmer, Trademark Examining Attorney, Law Office 121,  
Richard White, Managing Attorney.

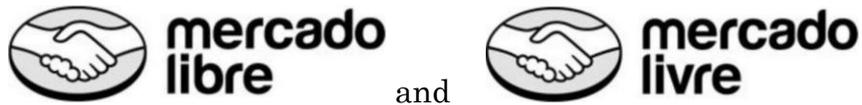
—  
Before Wellington, Coggins, and English,  
Administrative Trademark Judges.

Opinion by Coggins, Administrative Trademark Judge:

MercadoLibre, Inc. (“Applicant”) seeks registration on the Principal Register of  
the two marks shown below

---

<sup>1</sup> Although these appeals were not formally consolidated, we issue a single decision because the issues and records are essentially the same and the hearings were held jointly. *In re Pohl-Boskamp GmbH & Co.*, 106 USPQ2d 1042, 1043 (TTAB 2013) (two appeals involving common issues of law and fact decided in a single opinion). However, each proceeding retains its separate character and will result in the entry of a separate judgment for each appealed application; and a copy of this decision will be placed in each proceeding file. *In re Hudson News Co.*, 39 USPQ2d 1915, 1916 n.5 (TTAB 1996) (Board issued a single opinion in the interest of judicial economy, but each appeal stands on its own merits), *aff’d mem.*, 114 F.3d 1207 (Fed. Cir. 1997).



each for:

Operating online marketplaces for sellers of goods and services; online trading services, namely, operating online marketplaces for sellers and buyers of goods and services, including a wide range of home, business, vehicle services, real estate services, environmentally friendly products and professional services; online trading services in which the company and third parties post products or services to be offered for sale, and purchasing or bidding is done via the Internet in order to facilitate the sale of the company goods and services or third parties goods and services via a computer network; in International Class 35.<sup>2</sup>

The Trademark Examining Attorney refused registration of the marks (1) under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant's marks, as applied to the services identified in the applications, so resemble the standard-character mark FREEMARKET and the composite mark



on the Principal Register, owned by the same entity, and each for "operating online marketplaces for downloadable electronic media; online trading services in which sellers post items to be auctioned and bidding is done electronically," in International Class 35, as to be likely to cause confusion, to cause

---

<sup>2</sup> Application Serial Nos. 88950207 (for the MERCADO LIBRE mark) and 88950420 (for the MERCADO LIVRE mark) were filed on June 5, 2020, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the marks in commerce. The descriptions of the marks in the respective applications are essentially the same: "The mark consists of the design of a handshake enclosed in an oval with shading underneath the oval and the stylized wording 'MERCADO LIBRE' [or 'MERCADO LIVRE'] appearing to the right of the oval." Color is not claimed as a feature of the marks.

mistake, or to deceive;<sup>3</sup> and (2) pursuant to Trademark Rules 2.32(a)(9) and 2.61(b), 37 C.F.R. §§ 2.32(a)(9) and 2.61(b), requiring Applicant to submit an accurate English translation of the foreign wording in each mark.

## I. Prosecution and Appeal History

Application Serial Nos. 88950207 (MERCADO LIBRE) and 88950420 (MERCADO LIVRE) were originally filed identifying a long list of services in Class 35, including the services listed above.<sup>4</sup> In the first Office Action in each case, the Examining Attorney (1) refused registration under Section 2(d) of the Act based on cited Registration Nos. 4782132 and 5286337, but only as to some of Applicant's services in the application, i.e., those listed above; (2) required Applicant to provide an English translation of the foreign wording in the mark, suggesting the translation is "free market" based on evidence from Google Translate; and (3) required Applicant to specify more clearly the nature of a few of its services.<sup>5</sup> In its response, and without submitting any evidence, Applicant stated that it was "in discussions with the owner of the cited registrations for a potential agreement;" provided a statement that the

---

<sup>3</sup> Registration No. 4782132 (the standard character mark) registered July 28, 2015; Section 8 declaration accepted, Section 15 acknowledged. Registration No. 5286337 (the composite mark) registered September 12, 2017; this cited registration also includes goods and services in International Classes 9, 36, and 38, as well as additional services in Class 35, which were not cited as a bar to registration of Applicant's marks.

<sup>4</sup> Applications at 1-2. Citations to the prosecution record refer to the .pdf version of the TSDR system, and citations to the briefs in the appeal refer to the TTABVUE docket system. *See, e.g., In re Integra Biosciences Corp.*, 2022 USPQ2d 93, at \*7 (TTAB 2022). All citations to the record in this decision pertain to Serial No. 88950207 unless otherwise specified.

<sup>5</sup> September 9, 2020 Office Action.

English translation of the wording in each mark is “independent marketplace” or “free commerce;” and amended the identification of services.<sup>6</sup>

The Examining Attorney then noted that (1) inasmuch as Applicant did not submit arguments against the finding of a likelihood of confusion, the Section 2(d) refusal as to the specified services was made final; (2) although Applicant provided two possible translations of the wording in each mark, the requirement for an accurate translation was made final because Applicant failed to include the more accurate and previously suggested “free market” translation; and (3) the amended identification of services was acceptable.<sup>7</sup>

In response to the final refusals, Applicant concurrently filed for each application (1) a Request to Divide out the services not subject to the Section 2(d) refusal; (2) a Request for Reconsideration, with approximately 170 pages of evidence, traversing the Section 2(d) refusal and requirement for an additional translation; and (3) a Notice of Appeal requesting suspension of the appeal pending consideration of the request for reconsideration by the Examining Attorney.<sup>8</sup> The Board instituted and suspended the appeals, and remanded the applications to the Examining Attorney for consideration of the requests for reconsideration. The requests to divide were

---

<sup>6</sup> March 9, 2021 Response to Office Action.

<sup>7</sup> March 29, 2021 Office Action.

<sup>8</sup> See September 16, 2021 Request to Divide; September 16, 2021 Request for Reconsideration; and September 16, 2021 Notice of Appeal (1 TTABVue).

processed,<sup>9</sup> the Examining Attorney denied the requests for reconsideration, and the appeals were resumed.<sup>10</sup>

Applicant subsequently filed, and was granted, three 60-day motions to extend its time to file appeal briefs.<sup>11</sup> Applicant eventually filed its appeal briefs and attached new evidence thereto.<sup>12</sup> Once the cases were forwarded to the Examining Attorney for the Examining Attorney's briefs, Applicant requested suspension of the appeals and remand of the applications for further examination based on the new evidence that had been attached to its briefs.<sup>13</sup> The Board granted the requests and remanded the applications.<sup>14</sup> The Examining Attorney considered the new evidence but maintained the final refusals based on both a likelihood of confusion with the FREEMARKET marks in the cited registrations and the requirement for an accurate translation (as "free market").<sup>15</sup> The appeals were again resumed and the cases forwarded to the Examining Attorney for his briefs, which were duly filed.<sup>16</sup>

---

<sup>9</sup> Two divisional "child" applications were created: Application Serial Nos. 88983089 (for the MERCADO LIBRE mark) and 88983088 (for the MERCADO LIVRE mark) identifying the services not subject to the Section 2(d) refusals. *See* October 6, 2021 Office Action ("Notice that Processing of Request to Divide Application is Completed"). However, because the services in these child applications were also subject to the final requirement for an accurate translation, appeals were also instituted for the child applications. The appeals for the child applications have been suspended pending disposition of the appeals in the "parent" applications. *See* 9 TTABVUE in 88983089; 11 TTABVUE in 88983088.

<sup>10</sup> November 8, 2021 Reconsideration Letter; 5 TTABVUE (resumption order).

<sup>11</sup> 6, 8, 10 TTABVUE (motions to extend); 7, 9, 11 TTABVUE (orders granting extension).

<sup>12</sup> 12 TTABVUE 27-28.

<sup>13</sup> 14 TTABVUE.

<sup>14</sup> 15 TTABVUE.

<sup>15</sup> September 20, 2022 Reconsideration Letter.

<sup>16</sup> Upon resumption of the appeal for Application Serial No. 88950420 (the MERCADO LIVRE mark), the Board reset Applicant's time to file an appeal brief, apparently overlooking

Applicant then submitted its reply briefs, attaching 17 exhibits of new evidence thereto,<sup>17</sup> and concurrently filed a request for the Board to take judicial notice of the new material, or, in the alternative, to suspend the appeals and remand the applications for further examination of the new material.<sup>18</sup> The Board denied the alternative requests for remand due to Applicant's failure to demonstrate good cause therefor at such a late stage in the appeals, and deferred until final decision the requests for judicial notice.<sup>19</sup>

Applicant then requested an oral hearing,<sup>20</sup> which was held on May 9, 2023.<sup>21</sup> On the same day as the hearing, Applicant inquired via email about using a visual aid (i.e., a PowerPoint presentation) during the hearing. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 802.07 (2023) explains that a party wishing to present a visual aid at an oral hearing should email a copy of the visual aid to the Board at least three days prior to the hearing, and § 802.01 explains that

---

Applicant's earlier-filed brief. Applicant, following the Board's directive, filed a second appeal brief (which, but for some minor differences, effectively contains the same arguments as the first brief; and which the Board stated "supersedes" the first brief, *see* 21 TTABVUE 1 for 88950420). After the second brief was filed in this appeal, this case was forwarded to the Examining Attorney for his brief.

<sup>17</sup> 20 TTABVUE (Applicant's reply brief). Except for Exhibits 9 and 10, the new evidence attached to the respective reply briefs is effectively identical. For Application Serial No. 88950207 (MERCADO LIBRE) Exhibits 9-10 are French-to-English and Spanish-to-English dictionary entries for "libre," *see* 20 TTABVUE 35-45, while for Application Serial No. 88950420 (MERCADO LIVRE) they are French-to-English and Portuguese-to-English entries for "livre," *see* 24 TTABVUE 39-46.

<sup>18</sup> 20 TTABVUE (reply brief); 21 TTABVUE (request for judicial notice or remand).

<sup>19</sup> 24 TTABVUE.

<sup>20</sup> 26 TTABVUE.

<sup>21</sup> 28 & 29 TTABVUE. The hearings were scheduled and held in tandem, and Applicant was allowed the full time (i.e., for two hearings) to present its case.

an oral hearing may not be used to introduce additional evidence. Although the visual aid had not been sent to the Board or the Examining Attorney in advance, the Board allowed use of the aid after inquiring whether it recited any facts or contained any arguments based on material outside the record, asking Applicant to delete such matter, and confirming that the Examining Attorney did not object to its use as modified to remove the matter that was not of record.

The appeals are now before us for final decision. For the reasons explained below, we reverse the refusals to register each mark based on (1) Applicant's failure to comply with the Examining Attorney's requirement under Trademark Rules 2.32(a)(9) and 2.61(b) to submit an accurate English translation of the foreign wording in each mark; and (2) a likelihood of confusion under Trademark Act Section 2(d) with the standard-character mark FREEMARKET in Registration No. 4782132.<sup>22</sup>

## II. Evidentiary Issue

Before proceeding to the merits of the refusals, we address the outstanding evidentiary matter mentioned above. Applicant attached 17 exhibits of new evidence to each reply brief and asks the Board to take judicial notice thereof.<sup>23</sup>

Exhibits 1, 3, 4, 7-11, and 16 include online translation pages from COLLINS DICTIONARY and CAMBRIDGE DICTIONARY of various translations (e.g., English-to-Spanish, Spanish-to-English, Portuguese-to-English, French-to-English, or German-

---

<sup>22</sup> As explained below, we do not reach the Section 2(d) refusal based on the cited composite mark  freemarket.

<sup>23</sup> 20 TTABVUE 12-75 (exhibits); 20 TTABVUE 4 n.3, and 21 TTABVUE 1 (requests).

to-English) of various words (e.g., “Mary,” “mercado,” “gratuito,” “gratis,” “libre,” “livre,” or “über”); and Exhibits 2, 5, 6, 12, and 17 include webpages from Google Translate and SpanishDict of various translations (e.g., English-to-Spanish, Spanish-to-English, or German-to-English) of various terms (e.g., “Mary,” “mercado gratuito,” “mercado gratis,” “mercedes,” or “über”).

The Board may take judicial notice of U.S. dictionary definitions, including online dictionaries, definitions in technical dictionaries, and translation dictionaries that exist in printed format. *In re Omniome, Inc.*, 2020 USPQ2d 3222, at \*2 n.17 (TTAB 2019). In view thereof, we take judicial notice of the translations in Exhibits 1, 3, 4, and 16 from COLLINS DICTIONARY, for which Applicant submitted “American” translations; but we decline to do so for Exhibits 7-11 from CAMBRIDGE DICTIONARY, for which Applicant submitted “UK” (instead of “US”) translations. *See In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 n.7 (TTAB 2001) (Board cannot rely on a non-U.S. dictionary because it constitutes a foreign publication). We do not take judicial notice of the translations in Exhibits 2, 5, 6, 12, and 17 as, on the printouts submitted by Applicant, there is no indication that the Google Translate and SpanishDict websites fall into any of the acceptable categories or otherwise constitute authoritative sources of information. *Cf. In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB 2016); *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

Exhibits 13, 14, and 15 respectively include a page or brochure from an unknown source of Kantar Brandz’s “2022 Most Valuable Global Brands,” a TESS print out of Registration No. 1458809 for the mark MERCEDES-BENZ, and an infographic of “20 Things You Didn’t Know about Samsung” from Samsung’s news website. These exhibits clearly are not material of which the Board may take judicial notice. *In re Jimmy Moore LLC*, 119 USPQ2d at 1768 (on appeal, Board will not take judicial notice of definitions from commercial websites that do not constitute dictionary definitions); *In re House Beer, LLC*, 114 USPQ2d 1073, 1075 (TTAB 2015) (Board does not take judicial notice of files of applications or registrations residing in the Office). *See also* Fed. R. Evid. 201; TBMP § 1208.04. In view thereof, we do not take judicial notice of these exhibits. *See, e.g., In re ZeroSix, LLC*, 2023 USPQ2d 705, at \*1 (TTAB 2023) (citing Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d) (record should be complete prior to filing an appeal; evidence should not be filed with Board after filing of a notice of appeal)).

### III. Requirement for a More Accurate Translation

Trademark Rule 2.32(a)(9), 37 C.F.R. § 2.32(a)(9), requires that “[t]he application must be in English and ... [i]f the mark includes non-English wording, an English translation of that wording.” The TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 809.01 (2022) explains that a translation of non-English wording is required for proper examination because the foreign equivalent of an English term may be regarded in the same way as the English term for purposes of determining

descriptiveness, requiring a disclaimer, and citing marks under Section 2(d) of the Trademark Act.

The examining attorney may obtain the meaning of non-English wording through sources such as foreign language dictionaries and search engines. The examining attorney may also consult the Trademark Librarian or the Translations Branch, as appropriate.

\*\*\*

If the examining attorney determines the meaning of the non-English term(s), he or she must search the terms as they appear in the application, the transliterated terms, and the English translation(s) for the terms, as applicable. The examining attorney must also require (under 37 C.F.R. § 2.61(b)) that an accurate translation be made of record by the applicant using the researched translation or other accurate translation provided by applicant. If the applicant disputes a translation obtained through online resources, the examining attorney should supplement the record with evidence from the Trademark Librarian and/or the Translations Branch.

TMEP § 809.01. *See also In re Advanced New Techs. Co., Ltd.*, 2023 USPQ2d 60, at \*2-3 (TTAB 2023) (explaining § 809.01).

Citing to Google Translate, DeepL, Translate.com, and Systran Translate, the Examining Attorney contends that, while Applicant's proffered translations of the wording MERCADO LIBRE and MERCADO LIVRE in the marks as "independent marketplace" or "free commerce" are "not legally inaccurate,"<sup>24</sup> the most accurate translation of the wording is "free market."<sup>25</sup>

---

<sup>24</sup> 19 TTABVUE 13.

<sup>25</sup> 19 TTABVUE 12-13; September 9, 2020 Office Action (google.com); November 8, 2021 Reconsideration Letter (deepl.com, translate.com; & translate.systran.net (Application Serial No. 88950420 only)).

Applicant counters that the Examining Attorney's "narrow view" of the multiple meanings and translations of the wording in the marks is overly simplistic and is not supported as the most accurate translation when viewed in context of the evidence of record as a whole.<sup>26</sup> Applicant contends that the individual words MERCADO, LIBRE, and LIVRE each have multiple definitions, and that when the words are combined and considered together as they appear in the marks (as MERCADO LIBRE or MERCADO LIVRE) the preferred translation of the combined wording is "independent marketplace" or "free commerce," but could also be "open marketplace," "free exchange," "free trading," or "unhindered commerce" among many other meanings.<sup>27</sup>

Additionally, Applicant argues that (1) it has submitted an accurate translation of the foreign wording in each mark; (2) it has disputed the Examining Attorney's preferred translation which was derived from an online resource (i.e., Google Translate), and instead of supplementing the record with evidence from the Trademark Librarian or the Translations Branch as instructed by TMEP § 809.01, the Examining attorney turned to other online resources (i.e., DeepL, Translate.com, and Systran Translate); (3) the Examining Attorney should have deferred to Applicant's preferred translations given the absence of any evidence demonstrating that the preferred translations are misleading or otherwise incorrect; and (4) the Office has accepted Applicant's preferred translation in three prior applications for

---

<sup>26</sup> 12 TTABVUE 23; *See also* September 16, 2021 Request for Reconsideration at 18 ("[T]he Examining Attorney's cited Google translation is overly simplistic.").

<sup>27</sup> 12 TTABVUE 13-14.

marks incorporating the wording MERCADO LIBRE for goods or services similar to or overlapping with the services at issue in the current applications.<sup>28</sup>

We take judicial notice that “free market” means “[a]n economic market in which supply and demand are not regulated or are regulated with only minor restrictions.”<sup>29</sup> This definition comports with the Wikipedia entry of “free market” submitted by Applicant.<sup>30</sup> There is no evidence adduced by the Examining Attorney to suggest that MERCADO LIBRE or MERCADO LIVRE means “free market” as thusly defined in English. The Google Translate, DeepL, Translate.com, and Systran Translate webpages do not suggest anything other than a mechanical application of a literal translation of each component word in the marks.

The SpanishDict evidence submitted by the Examining Attorney – but not mentioned in his brief – purporting to demonstrate the Spanish-to-English translation of MERCADO LIBRE shows only a literal, “word-by-word” translation of the individual words without any indication that the term as a whole has any specific translation or meaning.<sup>31</sup> In addition, the DeepL webpages indicate that “open market” and “free trade” are alternative translations of MERCADO LIBRE, and that “open market,” “merchant market,” and “free trade” are alternative translations of

---

<sup>28</sup> 12 TTABVUE 24-25. *See also* September 16, 2021 Request for Reconsideration at 93-102, 138-167, & 180-84 (correspondence and TSDR record of Application Serial No. 85106948); 185-88 (TSDR printout of Application Serial No. 88950198); and 189-192 (TSDR printout of Application Serial No. 88950418).

<sup>29</sup> AMERICAN HERITAGE DICTIONARY (ahdictionary.com), accessed July 13, 2023.

<sup>30</sup> September 16, 2021 Request for Reconsideration at 23.

<sup>31</sup> November 8, 2021 Reconsideration Letter at 5.

MERCADO LIVRE.<sup>32</sup> These alternative translations are in line with the evidence submitted by Applicant of the translations and definitions of the individual words MERCADO, LIBRE, and LIVRE to demonstrate that the Examining Attorney's original online translation source returned a purely mechanical translation based on the individual words in each mark.<sup>33</sup>

There is no indication in the record that after Applicant disputed the Examining Attorney's preferred translation, which was initially obtained through a single online resource, the Examining Attorney attempted to supplement the record with more authoritative evidence from the Trademark Librarian or the Translations Branch, as instructed by TMEP § 809.01. The lack of corroborating evidence from any authoritative source undercuts the Examining Attorney's position which is based solely on translations conjured by online or machine-translating sites. We find the translation evidence which the Examining Attorney relies on has limited probative value. The Internet translators are not standard, authoritative dictionaries; they do not provide detailed definitions, usage notes, etymologies, alternative meanings,<sup>34</sup> or other information that might be provided by an authoritative dictionary.

---

<sup>32</sup> November 8, 2021 Reconsideration Letter at 3 in 88950420.

<sup>33</sup> See September 16, 2021 Request for Reconsideration at 25 (WordMagic translation and definitions of "mercado"), 26 (Interglot translation dictionary entry for "mercado"), 28 (WordMagic translation and definitions of "libre"); and at 33 (ReversoContext translation of "mercado"), 34 (bab.la translations and examples of "mercado"), 36 (ReversoContext translation of "livre"), and 37 (CAMBRIDGE DICTIONARY "US" translation of "livre") in 88950420.

<sup>34</sup> As mentioned above, the DeepL translator provides alternative translations, but there are no definitions and no indication that the alternatives are anything other than simple word-for-word alternatives.

When we take further judicial notice from the “American” or “US” versions of the COLLINS DICTIONARY and CAMBRIDGE DICTIONARY online resources upon which Applicant has relied, we are still left with doubt as to the most accurate and proper format for the translations of MERCADO LIBRE and MERCADO LIVRE. Specifically, COLLINS indicates that the translation of MERCADO LIBRE is “free market,” and directs the reader to “[s]ee full dictionary entry for **mercado** below.”<sup>35</sup> But, after following the “free market” link within that “entry for mercado below,” COLLINS indicates that the adjectival format of “free market” is “libre mercado” – a reversal of the words as they appear in the mark. Similarly, a search for “mercado libre” in the online CAMBRIDGE DICTIONARY returns only the similarly reversed “libre mercado” – not “mercado libre” – which reversed term CAMBRIDGE attributes to the noun “free trade.”<sup>36</sup>

The results are more direct for the Portuguese-to-English translations of MERCADO LIVRE. COLLINS returns the message of “[s]orry, no results for ‘mercado livre’ in the Portuguese-English Dictionary.”<sup>37</sup> CAMBRIDGE similarly returns no translation or meaning, but suggests to the reader that “[y]ou can also search for: ‘mercado’ [and] ‘livre’” as individual words, separately.<sup>38</sup>

---

<sup>35</sup> COLLINS DICTIONARY ([collinsdictionary.com/us/dictionary/spanish-english/mercado-libre](https://www.collinsdictionary.com/us/dictionary/spanish-english/mercado-libre)), last accessed July 13, 2023.

<sup>36</sup> CAMBRIDGE DICTIONARY ([dictionary.cambridge.org/us/dictionary/spanish-english/libre-mercado?q=mercado+livre](https://dictionary.cambridge.org/us/dictionary/spanish-english/libre-mercado?q=mercado+livre)), accessed July 13, 2023.

<sup>37</sup> COLLINS DICTIONARY ([collinsdictionary.com/us/spellcheck/portuguese-english?q=mercado+livre](https://www.collinsdictionary.com/us/spellcheck/portuguese-english?q=mercado+livre)), accessed July 13, 2023.

<sup>38</sup> CAMBRIDGE DICTIONARY (<https://dictionary.cambridge.org/us/spellcheck/portuguese-english/?q=mercado+livre>), accessed July 13, 2023.

The Board should not be left to chase down translations and meanings in this manner. What is clear from this exercise is that the record is inconclusive as to what the most accurate English translations of MERCADO LIBRE and MERCADO LIVRE would be to U.S. consumers. The Examining Attorney has not developed the record well enough to meaningfully defend the position that the most accurate translation of MERCADO LIBRE and MERCADO LIVRE is “free market.”

In view of Applicant’s challenge to the Examining Attorney’s preferred translations which were derived solely from online, apparent machine-translated resources, and which were not supplemented with evidence from the Trademark Librarian or the Translations Branch, the record does not support the Examining Attorney’s requirement for a more accurate translation of the foreign wording in either mark. Indeed, based on the record as presented to us in these appeals, and because “free market” carries a specific meaning in English, a translation of “free market” in either application on appeal potentially could be misleading. Based on the evidence of record, Applicant’s arguments are convincing. When the evidence as presented on appeal is scrutinized and viewed as a whole, it does not support a conclusion that the most accurate translation of MERCADO LIBRE or MERCADO LIVRE is “free market.”<sup>39</sup> Accordingly, the refusal to register based on the requirement under Trademark Rules 2.32(a)(9) and 2.61(b) for Applicant to submit a more accurate, English translation of the foreign wording in the mark is reversed for each application.

---

<sup>39</sup> Perhaps on a more developed record we might reach a different conclusion.

#### IV. Likelihood of Confusion

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the services of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d).

Our determination under Section 2(d) involves an analysis of all probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*,” setting forth factors to be considered and referred to as “*DuPont* factors”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Varying weights may be assigned to the *DuPont* factors depending on the evidence presented. See *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”). “Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the . . . services because the ‘fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the [services] and

differences in the marks.” *In re Embiid*, 2021 USPQ2d 577, at \*10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). See also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017).

For purposes of our likelihood of confusion analysis, we focus on the cited standard character mark FREEMARKET (Registration No. 4782132). We consider this mark to be the most relevant of the cited registrations for our *DuPont* analysis because it is registered in standard characters and, therefore, can be depicted in any font style, size, or color. Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a). If we do not find a likelihood of confusion with respect to this registered mark and its services, then there would be no likelihood of confusion with the other cited registration. See *In re Max Cap. Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. Similarity of the Services, Trade Channels, and Classes of Purchasers

“We begin with the second and third *DuPont* factors, which respectively consider ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’ and ‘the similarity or dissimilarity of established, likely-to-continue trade channels.’” *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*19 (TTAB 2021) (quoting *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) and *DuPont*, 177 USPQ at 567). We compare the services as they are identified in the involved applications and cited registration. *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, at \*3 (citing, inter alia, *Detroit Athletic Co.*, 128 USPQ2d at 1052).

Registrant's services are "operating online marketplaces for downloadable electronic media; online trading services in which sellers post items to be auctioned and bidding is done electronically." Applicant's services include, inter alia, "operating online marketplaces for sellers of goods and services; online trading services, namely, operating online marketplaces for sellers and buyers of goods and services, including a wide range of home, business, vehicle services, real estate services, environmentally friendly products and professional services."

The Examining Attorney argues that these services are legally identical;<sup>40</sup> and, apparently conceding the matter, Applicant makes no argument to the contrary. Based on these services, as described in the applications and registration, we find that Applicant's and Registrant's services are legally identical in part. *See In re Info. Builders Inc.*, 2020 USPQ2d 10444, at \*3 (TTAB 2020) (where registrant's broadly worded services are encompassed by applicant's recitation of services, "we find that Applicant's and Registrant's computer software design services are also legally identical in part.>").

Turning to the trade channels and consumers, because the services in the cited registration are in part legally identical to Applicant's services, we presume that they travel through the same channels of trade to the same classes of purchasers. *See Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Rsch. Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (where the services were legally identical, "the marketing channels of trade and targeted classes of consumers and donors are the same"); *see also In re*

---

<sup>40</sup> 19 TTABVUE 11.

*Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (where goods were identical, Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same).

The second and third *DuPont* factors thus weigh in favor of finding a likelihood of confusion.

#### B. Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we compare the marks “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). We assess not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the sources offered under the respective marks is likely to result. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018); *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). Where, as here, the services are legally identical, the degree of similarity of the marks necessary to find likelihood of

confusion lessens. *Cai v. Diamond Hong*, 127 USPQ2d at 1801; *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Registrant's mark is FREEMARKET. Applicant's marks are  and



. The crux of the Examining Attorney's argument is that MERCADO LIBRE and MERCADO LIVRE translate into English as "free market" from either Spanish or Portuguese, which are each common, modern languages spoken in the United States, and as such, the the ordinary American purchaser would likely stop and translate the foreign wording in Applicant's marks into "the same wording in the registered mark."<sup>41</sup>

Applicant, on the other hand, argues that because its marks share no visual or aural elements with the cited mark they are "totally dissimilar in terms of appearance and pronunciation."<sup>42</sup> Applicant further argues that "free market" is not the sole, possible translation of the wording in its marks which may more appropriately be translated as "independent marketplace" or "free commerce," and even include additional translations such as "open marketplace," "free exchange," "unhindered commerce," or "free trading," "among many other meanings."<sup>43</sup> Applicant concludes, noting that "[w]ith no element of the respective marks being even remotely similar, the [*DuPont*] . . . test cuts strongly against the Examining Attorney's finding of likely

---

<sup>41</sup> 19 TTABVUE 6-7.

<sup>42</sup> 12 TTABVUE 7, 17.

<sup>43</sup> 12 TTABVUE 13-14.

confusion,”<sup>44</sup> and that “a single [*Dupont*] factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.”<sup>45</sup>

Applicant and the Examining Attorney vigorously argue over whether the doctrine of foreign equivalents should apply to Applicant’s marks. “Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks.” *Palm Bay Imps.*, 73 USPQ2d at 1696 (citations omitted). The doctrine is not an absolute rule, and is subject to several limitations. It does not apply to words from dead or obscure languages, *In re Spirits Int’l N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1491 (Fed. Cir. 2009), and caution is indicated when the foreign term and the English to which it is compared are not exact synonyms, *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983).

As a general principle, the doctrine of foreign equivalents is applied in situations in which an American consumer is likely to “stop and translate” foreign words into their English equivalent. *Palm Bay*, 73 USPQ2d 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)). Applicant makes several arguments against application of the doctrine in these appeals, including that “the multiple translations of MERCADO LIBRE [and MERCADO LIVRE] make the doctrine of foreign

---

<sup>44</sup> 12 TTABVUE 7.

<sup>45</sup> 12 TTABVUE 16.

equivalents inapplicable . . . .”<sup>46</sup> We need not reach all of Applicant’s arguments against application of the doctrine, as Applicant’s argument as to the multiple translations persuades us that the doctrine does not apply here.

Because the Federal Circuit has stated the “[t]he test to be applied to a foreign word vis-à-vis an English word with respect to equivalency is not less stringent than that applicable to two English words,” *In re Sarkli, Ltd.*, 220 USPQ at 113, the English translation evidence of record is a critical factor when determining whether to apply the doctrine. If evidence shows that the English translation is unambiguously literal and direct, with no other relevant connotations or variations in meaning, the doctrine is applicable. *See, e.g., In re Ithaca Indus., Inc.*, 230 USPQ 702 (TTAB 1986) (holding LUPO for men’s and boy’s underwear and WOLF and design for various clothing items, likely to cause confusion, because, inter alia “LUPO” is clearly the foreign equivalent of the English word “wolf”). However, where the evidence shows that the English translation is not exact, literal, or direct, the doctrine of foreign equivalents has generally not been applied to find the marks confusingly similar. *See In re Sarkli*, 220 USPQ2d at 112-13 (holding REPÊCHAGE for various skin-products, and SECOND CHANCE for face creams and other toiletries, not likely to cause confusion, where the evidence failed to show that the terms were direct foreign equivalents); *see also In re Buckner Enters.*, 6 USPQ2d 1316 (TTAB 1987) (holding DOVE (with design) for stoves and furnaces, and PALOMA for various forms of gas heating apparatus, not likely to cause confusion, because, inter

---

<sup>46</sup> 12 TTABVUE 14.

alia, the Spanish word “paloma” and the English word “dove” are not exact synonyms in that “paloma” can be translated into either “dove” or “pigeon”).

After careful consideration of the dictionary and translation evidence of record, as discussed in detail above with the requirement for a more accurate translation, we find the Examining Attorney’s reliance on the doctrine of foreign equivalents misplaced. The record does not demonstrate that the English translation of MERCADO LIBRE and MERCADO LIVRE as “free market” is unambiguously literal and direct, with no other relevant connotations or variations in meaning.<sup>47</sup>

In terms of sound and appearance, we find the marks dissimilar to the extent that neither of Applicant’s marks contains wording similar in pronunciation or appearance to Registrant’s mark. MERCADO LIBRE and MERCADO LIVRE differ aurally and visually from FREEMARKET. However, because Registrant’s mark is in standard characters and it could appear in any font, we recognize that the marks potentially could be similar in appearance to the extent Registrant’s mark may appear in the same font used in Applicant’s composite marks. *See Viterra*, 101 USPQ2d at 1909 (holding that the specific font style of a mark cannot serve as the basis to distinguish it from a mark in standard character form); *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d at 1259 (registrant “entitled to depictions of the standard character mark regardless of font style, size, or color”).

---

<sup>47</sup> Just to cite one reference on which the Examining Attorney relies, and mentioned above, the DeepL webpages of record indicate that “open market” and “free trade” are alternative translations of MERCADO LIBRE, and that “open market,” “merchant market,” and “free trade” are alternative translations of MERCADO LIVRE. November 8, 2021 Reconsideration Letter at 5; and at 3 in 88950420.

Viewing Applicant's marks  and  and the cited mark FREEMARKET in their entirety, we find that they are different in sound, appearance, and commercial impression. Moreover, in view of the lack of equivalency in meaning, discussed in detail above, any possible similarity in meaning does not outweigh the strong dissimilarities. As such, the first *DuPont* factor favors Applicant.

### C. Absence of Evidence of Actual Confusion

Under the seventh and eighth *DuPont* factors, we consider the nature and extent of any actual confusion in light of the length of time and conditions under which there has been contemporaneous use of Applicant's and Registrant's subject marks. *DuPont*, 177 USPQ at 567. The seventh and eighth *DuPont* factors are interrelated; the absence of evidence of actual confusion, under the seventh *DuPont* factor, by itself is entitled to little weight in our likelihood of confusion analysis unless there also is evidence,<sup>48</sup> under the eighth factor, that there has been a significant opportunity for actual confusion to have occurred. *See In re Cont'l Graphics Corp.*, 52 USPQ2d 1374, 1377 (TTAB 1999); *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). Under the eighth *DuPont* factor, we "look at actual market conditions, to the extent there is evidence of such conditions of record." *See In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at \*6 (TTAB 2020).

---

<sup>48</sup> Applicant's repeated reliance on its Google Analytics evidence is unhelpful. As the analytics pages have not been translated from the Spanish, we do not rely on them. *See ARSA Distrib. v. Salud Nat. Mexicana S.A. De C.V.*, 2022 USPQ2d 887, at \*5 (TTAB 2022) (citing *Int'l Dairy Foods Assoc. v. Interprofession du Gruyère*, 2020 USPQ2d 10892, at \*7-8 (TTAB 2020) (giving no consideration to evidence consisting of documents in whole or in part in a foreign language without an English translation).

Here, Applicant's assertion that there have been no incidents of actual confusion is unpersuasive. "The fact that an applicant in an ex parte case is unaware of any instances of actual confusion is generally entitled to little probative weight in the likelihood of confusion analysis, inasmuch as the Board in such cases generally has no way to know whether the registrant likewise is unaware of any instances of actual confusion, nor is it usually possible to determine that there has been any significant opportunity for actual confusion to have occurred." *In re Opus One, Inc.*, 60 USPQ2d at 1817. There has been "no opportunity to hear from Registrant about whether it is aware of any reported instances of confusion. We therefore are getting only half the story." *Guild Mortg.*, 2020 USPQ2d 10279, at \*7.

Moreover, "[t]he relevant test is likelihood of confusion, not actual confusion." *Detroit Athletic Co.*, 128 USPQ2d at 1053. Indeed, "a showing of actual confusion is not necessary to establish a likelihood of confusion." *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002).

We therefore find the seventh and eighth *DuPont* factors to be neutral.

#### D. Balancing the *DuPont* Factors

Weighing the *DuPont* factors for which there has been evidence and argument in this appeal, *In re Charger Ventures LLC*, 65 F.4th 1375, 2023 USPQ2d 451, at \*7 (Fed. Cir. 2023), we find that even considering the in-part legally identical services, which are presumed to travel in the same channels of trade to the same classes of purchasers, the first *DuPont* factor is dispositive. The dissimilarities of the marks simply outweigh the other factors. *See Oakville Hills Cellar, Inc. v. Georgallis*

*Holdings, LLC*, 826 F.3d 1376, 119 USPQ2d 1286, 1290 (Fed. Cir. 2016) (“a single *[Du]Pont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks”); *Odom’s Tenn. Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) (“[E]ven if all other relevant *DuPont* factors were considered in [opposer’s] favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely.”); *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (Federal Circuit affirmed finding of no likelihood of confusion between mark CRYSTAL CREEK for wine and marks CRISTAL for wine and CRISTAL CHAMPAGNE for champagne, where Board relied solely on dissimilarity of marks); *Kellogg Co. v. Pack’em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *[Du]Pont* factor may not be dispositive”). Accordingly, on the record as presented in these appeals,<sup>49</sup> we find no likelihood of confusion.

## V. Decision

The refusal to register based on the requirement under Trademark Rules 2.32(a)(9) and 2.61(b) for Applicant to submit a more accurate, English translation of the foreign wording in the mark is reversed for each application.

---

<sup>49</sup> If there were more developed evidence relating to the translation and meaning of the foreign wording in Applicant’s marks, then we may have reached a different conclusion. The lack of corroborating evidence from any authoritative source to support the Examining Attorney’s assertion that each of Applicant’s marks translates to and means “free market” is fatal to both bases for refusal.

Serial Nos. 88950207 & 88950420

The refusal to register Applicant's marks under Trademark Act Section 2(d) based on a likelihood of confusion with the mark in Registration No. 4782132 is also reversed for each application.